

REMARKS

Claims 1-52 were originally pending in the application. Claims 2, 10, 14, 15, 21, 32, 36, 37 and 46-48 have been withdrawn from consideration pursuant to a restriction requirement and election of species, pending issuance of allowable generic or linking claim. In the Office Action dated August 20, 2003, the Examiner issued a final rejection of claims 1, 5-9, 13 and 50 as anticipated by U.S. Pat. No. 5,501,290 to Volz. Claims 1, 3, 5-9, 11, 13 and 50 were rejected as anticipated by U.S. Pat. No. 4,695,088 to Jensen. Claims 4 and 12 were rejected as obvious over Jensen in view U.S. Pat. No. 4,592,448 to Morris. Claims 16-20, 22-31, 33-35, 38-41, 44, 45, 49, 51 and 52 were rejected as obvious over Jensen in view of Morris and U.S. Pat. No 4,750,775 to Miller

Applicant disagrees with these ground of rejection and requests reconsideration of the application in light of the following remarks.

Withdrawal of Finality

Prior to discussing the rejections, Applicant requests the Examiner to withdrawal the Finality of the Rejection as being improperly issued. The Examiner stated that Applicant's prior amendment necessitated the new grounds of rejection. This is not a correct characterization of the amendment.

The only amendments made in response to the last office action were directed to informalities of dependent claims 25 and 26 pursuant to section 112, second paragraph. One amendment merely corrected a typographical error in claim dependency from being dependent on claim 24 to being dependent on claim 25. The other merely changed phraseology from reciting "or", which may be interpreted in the alternative, to reciting "at least one of ...and", which is properly interpreted as "and/or", which has no affect on the subject matter requiring a search since the Examiner must search for alternatives in either case. Therefore, neither of the these amendments added any limitation, altered any subject matter nor altered the scope or meaning of any claim in manner that would necessitate a new search. Applicant also submitted a declaration under section 1.131 to obviate the art cited in the last Office Action. The Examiner has now conducted a new search and cited new art in the present Office Action as a new grounds of rejection. Under these circumstances a Final Rejection is improper pursuant to section 706.07(a) of the MPEP which states in pertinent part:

Under present practice, second or any subsequent actions on the merits shall be final, *except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims* nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). (emphasis added)

Because Applicant's amendment did not alter the scope, content or meaning of any claim, the amendment clearly did not necessitate the new ground of rejection, and because the rejection is not based on information from an IDS, entry of the final rejection is improper. Accordingly, withdrawal of the finality of the rejection is requested.

The Claims and Rejections

Turning now to the claims and the rejections thereof, Applicant respectfully submits that the Examiner has overlooked important limitations as recited at least in the independent claims, and has improperly characterized the cited art as having these limitations where it does not. Independent claims 1, 16 and 49 are restated below with emphasis in *italics* for the elements missing from the cited art:

Claim 1 recites: A device for absorbing fluid leaked from a machined assembly, comprising:

an absorbent material that absorbs fluid leaked from the machined assembly; and
a mounting strip attached to a first part of the absorbent material, the mounting strip being removably attachable to an exterior portion of the machined assembly *to position a second part of the absorbent material at a location where fluid leaked from the machined assembly is absorbed by the absorbent material.*

Claim 16 recites: A device for absorbing fluid leaked from a machined assembly, comprising:

an absorbent material that absorbs fluid leaked from the machined assembly;
a first mounting strip attached to a first part of the absorbent material,
a second mounting strip configured to be attached to an exterior portion of the machined assembly, and
the first mounting strip being removably attachable to the second mounting strip
so that when the first mounting strip is attached to the second mounting strip, *a second part of*

the absorbent material is positioned at a location where fluid leaked from the machined assembly is absorbed by the absorbent material.

Claim 49 recites: A device for absorbing oil or transmission fluid leaked from an oil pan or transmission pan, comprising:

an absorbent material that absorbs the oil or transmission fluid leaked from the oil pan or transmission pan;

a first mounting strip attached to a first part of the absorbent material and, the first mounting strip having a first surface comprised of interlocking fabric hooks and loops;

a second mounting strip having a second surface comprised of interlocking fabric hooks and loops and a third surface that configured to attach to an oil pan or transmission pan, and

the first surface of the first mounting strip being removably attachable to the second surface of the second mounting strip so that when the second mounting strip is attached to the oil pan or transmission pan and the first mounting strip is attached to the second mounting strip, a second part of the absorbent material is positioned beneath a gasket of the oil pan to absorb the oil or transmission fluid leaked from the automotive component.

With respect to independent claim 1, neither Volz nor Jensen can fairly be characterized as disclosing *a mounting strip attached to a first part of the absorbent material*, the mounting strip being removably attachable to an exterior portion of the machined assembly *to position a second part of the absorbent material at a location where fluid leaked from the machined assembly is absorbed by the absorbent material.*

The Examiner cited item 18 in Volz as being a mounting strip attached to a first part of the absorbent material, which is labeled item 17. The absorbent material 17 is clearly not attached to the mounting strip at all, let alone being attached to *a first part of the mounting strip to position a second part of the absorbent material* at a location where fluid leaked from the machined assembly is absorbed by the absorbent material. As disclosed in column 3, lines 35-55 Volz teaches that item 18 is a flexible strap member *attached to an impervious film member* 11. The impervious film member contains pocket recesses 13 that are positioned beneath the oil pan. Inserted into the pocket recesses is an absorbent fibrous liner 17 designed to catch and entrap

fluids which drip therein. There is absolutely teaching that the fibrous liner 17 is attached to the flexible strap member.

Moreover, the overall design depicted in Volz would teach away from attaching the absorbent liner 17 to the flexible strap members 18. Clearly, the design is for a very large and semi-permanent mounting of the impervious film along the entire underside of the vehicle to protect the underside of the vehicle from road debris, and with the pockets 13 for the absorbent liner 17 being provided so that new absorbent liner 17 can be replaced within the pockets 13 from time to time, by being placed into the same impervious film 11 ~~and strap members 18~~. As Volz plainly states at column 2, lines 40-43, "it is a further object to the invention provide a new and improved vehicle drip shield which is of a *durable and reliable construction*." The skilled person would understand that the impervious film 11 is intended to be durably mounted to the bottom of the vehicle, while the absorbent liner is intended to be replaceable in the pockets. *Attaching* the absorbent liner to the mounting strap would defeat the ability to maintain the durable impervious film 11 and strap components 18 while replacing the fibrous liner 17. Moreover, as illustrated in each of the figures of Volz, the position of the flexible strap members 18 is situated on the frame of the vehicle, away from the position of the pockets 13 that ^{merely hold} had the fibrous liner 17, so it would make no sense to attach the fibrous liner 17 to the flexible straps 18.

Accordingly, Volz does not teach or suggest *a mounting strip attached to a first part of the absorbent material*, the mounting strip being removably attachable to an exterior portion of the machined assembly *to position a second part of the absorbent material at a location where fluid leaked from the machined assembly is absorbed by the absorbent material*. Each of the independent claims 1, 16 and 49 recite that the mounting strip is attached to the absorbent material. Volz, if anything, would teach away from such a design. Therefore, withdrawal of the rejections of claims 1, 3, 5-9, 11, 13, and 50 as anticipated by Volz is requested.

With respect to independent claims 1, 16 and 49, Jensen, like Volz also fails to teach the element of *a mounting strip attached to a first part of the absorbent material*, the mounting strip being removably attachable to an exterior portion of the machined assembly *to position a second part of the absorbent material at a location where fluid leaked from the machined assembly is absorbed by the absorbent material*, which is recited at various places in each of the independent claims. The Examiner cited item 26 of Jensen as being an absorbent

material and items 22-25 as a mounting strip to which the absorbent material is attached. This characterization of Jensen is not correct.

Jensen expressly teaches that “[a]bsorbent cartridge 26 is snugly fitted within cartridge recess 28 and is retained therein by the friction created between outer surface 30 of cartridge 26 and the interior wall of cartridge recess 28.” (Column 4, lines 64-67.) First, it is clear to the skilled person that being retained within the recess 28 by the action of friction is opposite to being *attached*. Second, there is no teaching anywhere that the absorbent cartridge 26 is attached to the flexible arms 22-25, which contain magnets that serve as a mounting surface for the device. Third, Jensen, like Volz, if any thing, clearly teaches away from the concept of attaching the absorbent material to the flexible arms. To the contrary, Jensen teaches that the absorbent cartridge 28 is designed to be replaceable within the oil drip catcher 10 independently of the flexible arms 22-25. More specifically Jensen teaches that “[a]bsorbent cartridge 26 is, as mentioned, retained within cartridge recess 28 by the friction between outer surface 30 and the cartridge recess. Accordingly, absorbent cartridge 26 may be easily removed for cleaning or replacement.” (Column 5, lines 39-43). The teaching of this section as well as the overall teaching of Jensen is clearly directed to having the absorbent cartridge replaceable while having a durable component that includes the mounting stirps provided by the flexible arms. To attach the cartridge to the flexible arms would destroy this functionality. Moreover, it is clear from the figures that if the cartridge were attached to the flexible arms, the cartridge would not be proximate to the position of the oil leak, since the flexible arms 22-25 extend outwardly from the receptacle 28 which is positioned beneath the leak.

Accordingly, Jensen not only fails to teach attaching mounting strips to the absorbent material, but in fact, *teaches away* from the concept of attaching the mounting strips to the absorbent material. Therefore, Jensen neither anticipates the invention of independent claim 1, but also teaches away from any design where the absorbent material is attached to the mounting stirps, such as is recited in each of independent claims 1, 16 and 49. Therefore withdrawal of the rejection of claims 1, 3-9, 11, 13 and 50 on grounds of anticipation is requested.

In addition withdrawal of the rejections of claims 4 and 12, as well as claims 16-20, 22-31, 33-35, 38-41, 44, 45, 49, 51 and 52, as obvious over Jensen in view of Morris or Morris and Miller is also requested. Not only do Morris and Miller fail to cure the deficiencies

of Jensen, one of ordinary skill in the art would find absolutely no motivation to use the fabric hooks of Morris or the adhesive material of Miller as mounting means that are to be *attached* to the absorbent material because Jensen teaches the opposite concept of having the absorbent material not attached to the mounting means. Accordingly, not only would the skilled person find no motivation to combine Jensen with Morris and/or Miller, but the combination would still fail to teach all the elements of the claimed invention, especially attachment of the absorbent material to the mounting means. Therefore, the Examiner has not established a prima facie case of obviousness by either (1) citing references that together disclose on all the elements of the invention or (2) by showing a motivation or suggestion in the art to combine references in a manner that would yield the claimed invention.

The present remarks have focused on the element of having the absorbent material attached to the mounting strips as recited in each of the independent claims 1, 16 and 49. Because these independent claims are clearly allowable for reciting this element alone, all claims that depend thereon are also allowable at least for that reason. The independent claims and dependent claims are also allowable on many other grounds as well. For example, the elements of first and second portions of the absorbent material being in different locations, the elements of first and second mounting strips, and the further combination of the precise positioning of the elements recited in the independent claims all further distinguish over the cited art. Moreover, the specific combinations cited in the dependent claims are also not taught or suggested by the cited references. In the interest of brevity, Applicant does not discuss other separate grounds of patentability of each of the claims independently because the claims are allowable at least for the reasons discussed above. This expedient is not an admission that the patentability of any dependent claim rises or falls with patentability of the independent claims, and Applicant reserves the right to discuss various other grounds of patentability at a later time if necessary.

The Drawings

The Examiner objected to the drawings for failing to show the recessed dimension, which was discussed in the specification on page 5, lines 15-17. A new drawing Figure 5A is submitted herewith along with an amendment to the specification to make reference to the recess and the drawing by number.

All of the claims remaining in the application are now clearly allowable.
Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

DORSEY & WHITNEY LLP

A handwritten signature in black ink, appearing to read 'Mark W. Roberts', is written over the printed name.

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Enclosures:

- Postcard
- Check
- Fee Transmittal Sheet (+ copy)
- Notice of Appeal (+ copy)
- Replacement Drawing Sheet (Figs 1-5A)

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